

REMARKS

This is in response to the Office Action mailed on February 11, 2009. Claims 1-18, 20-52, and 58-67 were pending in that action, and the Examiner rejected all of the claims. With the present response, claims 1, 17, 24, 33, and 58 are amended, claims 7-9, 22, 36, and 62-67 are canceled, and the remaining claims are unchanged.

Applicant would like to highlight that no new issues are being presented with this amendment. Claim 1 has been amended to include the limitations previously recited in its dependent claims 7-9 such that claim 1 is the former claim 9 re-written in independent form. Claim 17 has been amended to include the limitations previously recited in its dependent claim 22 such that it is the former claim 22 re-written in independent form. Claim 33 has been amended to include the limitations previously recited in its dependent claim 36 such that claim 33 is the former claim 36 re-written in independent form. Claim 58 has been amended to include the limitations previously recited in its dependent claim 62 such that claim 58 is the former claim 62 re-written in independent form. Claim 24 formerly depended upon now canceled claim 22 and has been amended to depend upon amended claim 17.

Applicant is only requesting that the Examiner reconsider limitations and combinations of limitations that the Examiner has previously reviewed. Applicant is not requesting that the Examiner consider any new basis of patentability such as a new combination of elements.

Applicant respectfully requests that the Examiner enter the amendments and consider Applicant's remarks in support of patentability of the claims. As is stated in MPEP 714.12 in regards to amendments after a Final Rejection, "[a]ny amendment that will place the application either in condition for allowance or in better form for appeal may be entered." Applicant respectfully contends that the amendments satisfy the requirements of MPEP 714.12. Applicant contends that the amendments place the application in condition for allowance. Alternatively, Applicant contends that the amendments place the application in better form for appeal by reducing the number of claims and simplifying issues to be determined at appeal. Accordingly, reconsideration and allowance of all pending claims are respectfully solicited in light of the following remarks.

Request to Withdraw Finality of the Office Action

Applicant respectfully requests that the Examiner withdraw the finality of the Office Action and issue a new non-final Office Action. In section 8 of the Office Action, the Examiner stated that “Applicant’s arguments with respect to claims 1-18, 20-52, and 58-62 have been considered but are moot in view of the new ground(s) of rejection.” In the Office Action, the Examiner examined independent claim 58 as it was originally presented (i.e. claim 58 had not been amended). As is stated in MPEP 706.07(a), “[u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)[.]” In the present case, the Examiner’s new ground of rejection of independent claim 58 was neither necessitated by an amendment made by the Applicant or by an IDS submitted by the Applicant. Accordingly, the finality of the Office Action is not appropriate under MPEP 706.07(a). Applicant respectfully requests that the finality be withdrawn and that a non-final Office Action be issued.

Claim Rejections - 35 USC § 112

In sections 4-7 of the Office Action, the Examiner rejected claim 2 under 35 USC §112. Although Applicant respectfully disagrees with the Examiner, claim 2 is being canceled with this amendment to reduce the number of outstanding issues in the case. Applicant respectfully requests that the §112 rejections be withdrawn.

Claim Rejections -35 USC § 103

In sections 6-81 of the Office Action, the Examiner rejected claims 1-18 and 20-62 under 35 USC 103(a). As is discussed below, Applicant respectfully contends that the claims include limitations that are not disclosed by the cited references and that are not obvious in view of the cited references. Because of this, Applicant respectfully contends that the claims are patentable.

Claim 1:

Applicant respectfully contends that claim 1 includes several limitations that are patentable over the cited references. First, claim 1 recites in part that the supplemental header includes a contract identification field which identifies a contract with a payment provider, that the gateway memory includes a listing of valid contract identifications, and that the gateway processor compares the data in the contract identification field to the listing of valid contract identifications. In sections 10 and 21 of the Office Action, the Examiner stated that these limitations are disclosed by Willard U.S. Pat. Pub. No. 2005/0192892 (hereinafter “Willard”). Applicant respectfully disagrees.

Willard does not disclose a field which identifies a contract with a payment provider, and thus does not disclose comparing the data in that field to a listing of valid contract identifications. As the Examiner notes in section 10 of the Office Action, Willard discloses comparing security information such as a PIN. Applicant respectfully contends that this security information does not disclose the claimed contract information. Security information such as a PIN is used to prevent unauthorized users of a system from successfully completing a transaction. For example, a PIN requirement/verification limits the users who can successfully complete a transaction to only those people who know the PIN. The Willard security information is a different type of information than the claimed contract identification data. The Willard security information does not relate to a valid contract with a payment provider.

Next, as was previously mentioned, claim 1 has been amended to include the limitations previously recited in its dependent claims 7, 8, and 9. The former claim 9 limitation recites in part that the financial authorization requests include a cache-key which identifies data in the cache and that the cache-key comprises a 128 bit data field. In section 42 of the Office Action, the Examiner stated that the former claim 9 limitation is disclosed by paragraphs 43 and 51 of Willard. Applicant respectfully disagrees.

Applicant would like to first point out that Willard clearly does not disclose the claim limitation of a 128 bit data field. Willard does not disclose that any of its various types of data include a 128 bit data field. Additionally, in the Office Action, the Examiner seems to be

indicating that either the Willard security PIN or perhaps the Willard account number discloses the claimed cache-key. Willard does not disclose that either its PIN or account number includes a 128 bit data field. Additionally, the Examiner has not provided any reasoning for why it would be obvious to modify Willard to include a cache-key that comprises a 128 bit data field.

For at least the reasons discussed above, Applicant respectfully contends that claim 1 is patentable over the cited references. Applicant respectfully requests that the rejection be withdrawn and the claim allowed.

Claim 17:

Claim 17 previously recited in part that merchant or store/location invariant data is stored in the gateway memory and that the data is retrieved based upon the cache-key field. As was previously mentioned, claim 17 has been amended to include the limitations previously recited in its dependent claim 22. Those limitations further narrow claim 17 by reciting that the data that is stored and retrieved includes a merchant name, a location, a merchant category code, and an acquirer bin. An illustrative embodiment of the limitations is described in page 11 of the specification that states that “[t]he transaction authorization protocol 200 illustrated in Figure 5 also provides a cache-key field 204. The cache-key 204 can be used to uniquely identify a particular shop or store submitting an authorization request. Merchant data can also be cached, for example for merchants with multiple stores. The payment processing gateway 16 can retrieve cache data within memory 34 illustrated in Figure 2 based upon the cache-key.” Applicant respectfully contends that these limitations are patentable over the cited references.

In section 12 of the Office Action, in rejecting the former claim 17 limitation of merchant or store/location invariant data, the Examiner stated that this was disclosed by Willard. In particular, the Examiner stated that Willard stores and retrieves a merchant’s name and that the merchant’s name alone discloses merchant invariant data. With the present amendment, the merchant or store/location invariant data includes a merchant name, a location, a merchant category code, and an acquirer bin. Thus, even if the Willard merchant name did disclose the merchant invariant data, the Willard merchant name does not disclose the merchant invariant data as recited in amended claim 17.

In section 60 of the Office Action, in rejecting the former claim 22 limitation that the data includes a merchant name, a location, a merchant category code, and an acquire bin, the Examiner took Official Notice that it was old and well known in the art to have various data on file for merchants. The Examiner also stated that it would have been obvious to one of ordinary skill in the art at the time of the invention to link the merchant with their data information in a data storage area. Applicant respectfully disagrees.

Applicant is not contending that the claimed types of data are in themselves new. As Applicant states on pages 11-12 of his specification, prior art systems included this data. However, in the prior art systems, this data is sent with each transaction request. Applicant is instead contending that storing the data in a gateway server and then retrieving the data based on a cache-key is new. As was stated in the case of *In re Gordon*, the question of whether a claim limitation is obvious in view of the prior art depends on whether it would have been obvious from a fair reading of the prior art reference as a whole to modify the prior art to include the claim limitation. *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Applicant respectfully contends that even if the merchant name in Willard discloses the claimed merchant invariant data, that there is nothing in Willard that would provide any reason for including any merchant invariant data beyond the merchant name.

Also in section 60 of the Office Action, the Examiner stated that the Official Notice is further supported by Langhans et al., U.S. Pat. No. 5,621,201 (hereinafter “Langhans”). The sections of Langhans cited by the Examiner do disclose various types of data for a merchant. Langhans however does not disclose retrieving this data based on a cache-key in a transaction authorization request. Instead, Langhans discloses that its merchant data is included in a report that is generated in response to the completion of a billing cycle.

For at least the reasons discussed above, Applicant respectfully contends that claim 17 is patentable over the cited references. Applicant respectfully requests that the rejection be withdrawn and the claim allowed.

Claim 33:

As has been previously mentioned, claim 33 has been amended to include the limitations previously recited in its dependent claim 36. Applicant respectfully contends that claim 33 is patentable at least because the limitations previously recited in claim 36 are patentable. The former claim 36 recites in part that the cache key includes data indicative of a merchant and data indicative of a store and that the data indicative of a merchant comprises 12 bytes and that the data indicative of a store comprises 4 bytes. An illustrative embodiment of the limitation is described for example in page 11 of the specification that states that “[i]n another specific example, 12 bytes of the 128 bits identifies a particular merchant while the remaining 4 bytes identifies a particular store of that merchant.”

In sections 38 and 45 of the Office Action, the Examiner stated that the former claim 36 limitation is disclosed by Willard in view of Narin U.S. Pat. No. 6,966,034 (hereinafter “Narin”) in further view of Epstein U.S. Pat. Pub. No. 2003/0004828 (hereinafter “Epstein”) and in further view of Official Notice. In particular, in section 45 of the Office Action, the Examiner stated that paragraphs 43-47 of Willard teach a memory key that comprises data indicative of a merchant, and that Official Notice is taken that the use of cache memory is old and well known. Applicant respectfully disagrees with the rejection.

Willard arguably discloses transmitting data indicative of a merchant with a transaction request. Willard however does not disclose transmitting both data indicative of a merchant and data indicative of a store. Willard certainly does not disclose that the data indicative of a merchant comprises 12 bytes and that the data indicative of a store comprises 4 bytes.

Additionally, Applicant would like to highlight the fact that in rejecting the limitation in section 45 of the Office Action, that the Examiner did not provide any support or reasoning for why it would be obvious to modify Willard to include data indicative of a store or why it would be obvious to modify Willard to include the claimed 12 bytes and 4 bytes.

Because the Examiner has not shown that all of the claimed limitation are disclosed by the cited references or provided any support for why it would be obvious to modify the cited references to include all of the claimed limitations, Applicant respectfully contends that the

rejection of the claim is improper. Applicant respectfully requests that the rejection be withdrawn and the claim allowed.

Claim 58:

As was previously mentioned, claim 58 has been amended to include the limitations previously recited in its dependent claim 62. The former claim 62 recited in part that operation of the gateway processor on the first financial transaction authorization requests is stateless and that the gateway processor maintains a thread. An illustrative embodiment of the limitations is described for example in page 16 of the specification that states that “[a]s discussed above, web services are inherently stateless. Therefore, without additional implementation, the final acknowledgement may go to a different thread than the original transaction, and possibly even to a different server in a web cluster. In one aspect, the present invention maintains a thread in the web service such that such an acknowledgement can be sent to the appropriate financial institution.”

In section 83 of the Office Action, the Examiner stated that the stateless limitation is disclosed by Jacobs U.S. Pat. No. 6,334,114 (hereinafter “Jacobs”) and that the maintaining a thread limitation is disclosed by Nicolaisen 1997 (hereinafter “Nicolaisen”). First, Applicant does not believe that Nicolaisen discloses maintaining a thread. In the Office Action, the Examiner states that the limitation is disclosed by pages 1-8 of Nicolaisen. Applicant only sees one mention of any variation of the word “thread” in Nicolaisen. Page 2 of Nicolaisen states that the new software package for designing, creating, and managing interactive web content tightly interweaves the disparate threads of web publishing. Nicolaisen does not disclose a processor maintaining a thread. It only discloses a web developer interweaving disparate threads.

Additionally, even if the cited references did disclose all of the claimed limitations, Applicant does not believe that it would not be obvious to combine all of the references as the Examiner has done in rejecting the claim. As was stated in the case of *Interconnect Planning Corp. v. Feil*, “[i]t is impermissible to first ascertain factually what appellants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants’ invention from such prior art.”

Interconnect Planning Corp. v. Feil, 227 U.S.P.Q. 543, 550 (Fed. Cir. 1985). The court went on to state that “[w]hen prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.” *Id.* at 551. “There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.” *Id.*

In the present case, Applicant respectfully contends that there is nothing in the prior art that would suggest combining the Jacobs and Nicolaisen references with the other three references used in rejecting the claim. Claim 58 is directed to a financial transaction. The main reference that the Examiner has used in rejecting claim 58 is Willard, which is also directed to a financial transaction. The Jacobs and Nicolaisen references are not however related to financial transactions. Applicant respectfully contends that there is no factually supported basis for combining Jacobs and Nicolaisen with the other three references. Instead, the Examiner is using Applicant’s disclosure and claims to piece together random teachings from prior art.

For at least the reasons discussed above, Applicant respectfully contends that claim 58 is patentable over the cited references. Applicant respectfully requests that the rejection be withdrawn and the claim allowed.

Claims 2-6, 10-16, 18, 20-21, 23-32, 34-35, 37-52, and 59-61:

Claims 2-6, 10-16, 18, 20-21, 23-32, 34-35, 37-52, and 59-61 are dependent claims. Applicant respectfully contends that the claims are allowable at least based on their dependence upon allowable independent claims. Applicant respectfully requests that the rejections be withdrawn and the claims allowed.

Conclusion

It is respectfully submitted that claims 1, 17, 33, and 58 are patentably distinguishable over the cited references. It is also respectfully submitted that dependent claims 2-6, 10-16, 18, 20-21, 23-32, 34-35, 37-52, and 59-61 are patentable at least based on their dependence upon the patentable independent claims. Accordingly, Applicant respectfully submits that the entire

application is now in condition for allowance. Reconsideration and favorable action are respectfully requested.

Also, it is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue, or comment, including the Office Action's characterizations of the art, does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment or cancellation of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment or cancellation. Applicant reserves the right to prosecute the rejection claims in further prosecution of this or related applications.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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